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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,564	10/23/2000	Steve W. Irons	IMAG-0123	1951

7590 06/18/2004

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EXAMINER

LETT, THOMAS J

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,564

Applicant(s)

IRONS ET AL.

Examiner

Thomas J. Lett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 22-27 is/are rejected.
- 7) ☒ Claim(s) 18-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT II
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2 recites the limitation " the globally unique document number " in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 3 recites the limitation " the globally unique document number " in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 17 recites the limitation " the paper-based document " in lines 5, 6, 8, and 10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Lundberg (US Pat. Pub. 20040107153 A1). Lundberg discloses that each of the server 610 (*apparatus*) and computers, or remote terminals 612 includes a processor (such as an Intel Pentium processor) (para 186, lines 5-7), which reads on an apparatus comprising at least one processor;

each of the server 610 and computers, or remote terminals 612 include processors, random access memory, and read-only memory (para 186, lines 5-9), which reads on a memory coupled to the at least one processor;

a fax server containing a database (*memory*) from which is sent a fax copy of an invoice cover sheet (*digital image*) having an image bar code (para 144, lines 12-13), which reads on at least one digital image of a paper-based document, the digital image comprising at least one image of a dynamically generated fax cover sheet, the at least one digital image residing in the memory; and

the software means(*digital filing application*) described above is further operable on the fax server in memory of 610, reads the bar code and automatically attaches the digital image of the fax copy of the work product and the fax copy of the invoice cover

sheet to the associated invoice in the database of invoices on the server (para 144, lines 18-22), which reads on a digital filing application residing in the memory and being executed by the at least one processor, the digital filing application extracting a globally unique identifier(*bar code*) from the image of the dynamically generated fax cover sheet and using the globally unique identifier to link the digital image to a database record which was created prior to the creation of the digital image.

With respect to claim 4, Lundberg discloses that the network may be any type of network, such as an Ethernet network, a token-ring network, etc. Each of the server 610 and computers, or remote terminals 612 includes a processor (such as an Intel Pentium processor) (para 186, lines 3-5 and see Fig. 6), which reads on a communication link coupled to the at least one processor.

With respect to claim 5, Lundberg discloses specifically in FIG. 6, the firm computer system includes a local-area network (LAN) having a server 610 coupling together a plurality of computers 612 (para 186, lines 1-3), which reads on the communication link comprises a computer network.

With respect to claim 6, Lundberg discloses that the software means described above is further operable on the fax server, reads the bar code and automatically attaches the digital image of the fax copy of the work product and the fax copy of the invoice cover sheet to the associated invoice in the database of invoices on the server (para 144, lines 18-22), which reads on the digital filing application transfers the digital image of the paper-based document to an image repository via the communication link.

With respect to claim 7, Lundberg discloses that the network may be any type of network, such as an Ethernet network, a token-ring network, etc (para 186, lines 3-4), which reads on the computer network is the internet.

With respect to claim 8, Lundberg discloses that the network may be any type of network, such as an Ethernet network, a token-ring network, etc (para 186, lines 3-4), which reads on the computer network is an intranet.

With respect to claim 9, Lundberg discloses that a fax copy of an invoice cover sheet having an image bar code (*globally unique identifier*), where the image bar code has a file number and an invoice number (para 144, lines 9-11), which reads on the globally unique identifier comprises a number represented as a bar code on the digital image of the dynamically-generated fax cover sheet.

6. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al (US Patent 6,603,569 B1). Johnson et al discloses the form's definition can indicate that a new form, a cover sheet, or another image should be automatically created (col 12, lines 63-63), which reads on a dynamically-generated fax cover sheet ; Fig. 7 shows several dynamic fields or zones on forms, which reads on at least one dynamic content zone, each form shown has its own unique identifying (*globally unique identifier*) information, and this information can be generated at the time the form is created, based on a function of an identifier of the software installation (*digital filing application*) that creates the form (col 15, lines 20-24), which reads on at least one of the dynamic content zones contains a globally unique identifier which was generated by a digital filing application.

With respect to claim 23, Johnson et al discloses in Fig. 7 a static zone containing the term "Send", which reads on at least one static content zone.

With respect to claim 24, Johnson et al discloses that the box in field 552 is marked to specify that the automatically created form should also include a list of all documents in information database 322 (col 15, lines 60-63), which reads on at least one of the at least one dynamic content zone contains a piece of system-generated data which is document-specific information.

With respect to claim 25, Johnson et al discloses that alternatively, it could include a write-in recipient segment, a documents segment, an options segment, and a cover note segment. At the bottom of each automatically created form is a segment with the user's name and a date (col 17, lines 12-16), which reads on at least one of the at least one dynamic content zone contains a piece of system-generated data which is user-specific information.

With respect to claim 26, Johnson et al discloses that the box in field 552 is marked to specify that the automatically created form should also include a list of all documents in information database 322 (col 15, lines 60-63), which reads on at least one of the at least one dynamic content zone contains a piece of user-generated data which is document-specific information.

With respect to claim 27, Johnson et al discloses alternatively, it could include a write-in recipient segment, a documents segment, an options segment, and a cover note segment. At the bottom of each automatically created form is a segment with the user's name and a date (col 17, lines 12-16), which reads on at least one of the at least

one dynamic content zone contains a piece of user-generated data which is user-specific information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10–16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundberg (US Pat. Pub. 20040107153 A1) in view of Johnson et al (US Patent 6,603,569 B1). Lundberg discloses that each of the server 610 (*apparatus*) and computers, or remote terminals 612 includes a processor (such as an Intel Pentium processor) (para 186, lines 5-7), which reads on an apparatus comprising at least one processor;

each of the server 610 and computers, or remote terminals 612 include processors, random access memory, and read-only memory (para 186, lines 5-9), which reads on a memory coupled to the at least one processor;

a fax server containing a database (*memory*) from which is sent a fax copy of an invoice cover sheet (*digital image*) having an image bar code (para 144, lines 12-13), which reads on at least one digital image of a paper-based document, the digital image comprising at least one image of a dynamically generated fax cover sheet, the at least one digital image residing in the memory; and

the software means(*digital filing application*) described above is further operable on the fax server in memory of 610, reads the bar code and automatically attaches the digital image of the fax copy of the work product and the fax copy of the invoice cover sheet to the associated invoice in the database of invoices on the server (para 144, lines 18-22), which reads on a digital filing application residing in the memory and being executed by the at least one processor, the digital filing application extracting a globally unique identifier(*bar code*) from the image of the dynamically generated fax cover sheet and using the globally unique identifier to link the digital image to a database record which was created prior to the creation of the digital image.

With respect to claim 10, Lundberg does not disclose the dynamically generated fax cover sheet comprises at least one dynamic content zone. Johnson et al disclose that the form's definition can indicate that a new form, a cover sheet, or another image should be automatically created (col 12, lines 63-63), and Fig. 7 shows several dynamic fields or zones on forms. Lundberg and Johnson et al are analogous art because they are from the similar problem solving area of creating fax cover sheets. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Johnson et al to Lundberg in order to obtain fax cover sheets with a dynamic content field. The motivation for doing so would be to enter dynamic information to a document.

With respect to claim 11, Lundberg does not disclose the at least one dynamic content zone contains the globally unique identifier. Johnson et al disclose that Fig. 7 shows several dynamic fields or zones on forms and each form shown has its own

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unique identifying information, and this information can be generated at the time the form is created, based on a function of an identifier of the software installation that creates the form (col 15, lines 20-24). Lundberg and Johnson et al are analogous art because they are from the similar problem solving area of creating fax cover sheets. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Johnson et al to Lundberg in order to obtain unique fax cover sheets. The motivation for doing so would be to represent the unique identifier in a dynamic field.

With respect to claim 12, Lundberg does not disclose comprising at least one static content zone. Johnson et al disclose in Fig. 7 a static zone containing the term "Send", which reads on at least one static content zone. Lundberg and Johnson et al are analogous art because they are from the similar problem solving area of creating fax cover sheets. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Johnson et al to Lundberg in order to obtain fax cover sheets containing a static region. The motivation for doing so would be to show data that is constant.

With respect to claim 13, Lundberg discloses a fax server containing a database (*memory*) from which is sent a fax copy of an invoice cover sheet (*digital image*) having an image bar code (para 144, lines 12-13), which reads on the globally unique identifier comprises a number represented as a bar code on the dynamically generated fax cover sheet.

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With respect to claim 14, Lundberg does not disclose that the dynamically generated fax cover sheet comprises a plurality of dynamic content zones. Johnson et al disclose that Fig. 7 shows several dynamic fields or zones on forms. Lundberg and Johnson et al are analogous art because they are from the similar problem solving area of creating fax cover sheets. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Johnson et al to Lundberg in order to obtain fax cover sheets containing multiple dynamic regions. The motivation for doing so would be to show multiple dynamic fields for information use.

With respect to claim 15, Lundberg does not disclose the apparatus comprising a plurality of static content zones. Johnson et al disclose in Fig. 7 a static zone containing the terms "Send", "Add Recipient", and "Document A". Lundberg and Johnson et al are analogous art because they are from the similar problem solving area of creating fax cover sheets. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Johnson et al to Lundberg in order to obtain fax cover sheets containing multiple static regions. The motivation for doing so would be to show multiple static fields for indicating information.

With respect to claim 16, Lundberg does not disclose apparatus wherein at least one of the at least one dynamic content zone contains the globally unique identifier. Johnson et al disclose that the form's definition can indicate that a new form, a cover sheet, or another image should be automatically created (col 12, lines 63-63), and Fig. 7 shows several dynamic fields or zones on forms. Lundberg and Johnson et al are analogous art because they are from the similar problem solving area of creating fax

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cover sheets. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Johnson et al to Lundberg in order to obtain fax cover sheets with a dynamic content field. The motivation for doing so would be to enter dynamic information to a document.

Allowable Subject Matter

8. Claims 18-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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Washington, DC 20231

or Faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to:

Crystal Park II

2121 Crystal Drive

Arlington, VA

Sixth Floor (Receptionist).

TJL

JEROME GRANT II
PRIMARY EXAMINER